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DAVID A. GUERRA			NGUYEN, VI X	
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CANADA				

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID A. GUERRA

Appeal 2015-000649
Application 13/296,092
Technology Center 3700

Before JILL D. HILL, THOMAS F. SMEGAL, and GORDON D. KINDER,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

David A. Guerra (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 17, 18, and 20.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Claims 1–16 have been withdrawn (Appeal Br. 11–12 (Claims App.)), and claim 19 is indicated as containing allowable subject matter (Final Act. 3).

BACKGROUND

Sole independent claim 17, reproduced below, represents the claimed invention, the key disputed limitation italicized.

17. A pacifier comprising:
a base section;
an upper mouth member having a first portion extending from said base section, said upper mouth member being configured to be positioned adjacent a roof of a mouth of a user;
a sublingual member having a first portion extending from said base section, said sublingual member being configured to be received in a sublingual pocket of the mouth of the user;
a transition section between a second portion of said upper mouth member and a second portion of said sublingual member, *said transition section having a profile that defines a pocket configured to receive a portion of a tongue of the user*;
and
a temperature sensor unit fitted to said sublingual member and configured to come in contact with the sublingual pocket of the user when said pacifier is received in the mouth of the user.

REJECTION

Claims 17, 18, and 20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Zeindler (US 5,534,013, iss. July 9, 1996). Final Act. 2.

OPINION

Independent claim 17 recites, *inter alia*, an upper mouth member configured to be positioned adjacent a roof of a mouth, a sublingual member configured to be received in a sublingual pocket of the mouth, and a transition section therebetween having a profile defining a pocket configured to receive a tongue. The Examiner finds that Zeindler discloses the subject

matter of claim 17, including the recited “transition section (the area of 5).”
Final Act. 2.

Appellant argues that Zeindler’s head 4 has a flattened head section 4’ on its tongue side, comprising a continuous wall without a pocket “configured to receive a portion of a tongue.” Appeal Br. 6. Appellant further contends that Zeindler’s head 4 cannot be both “configured to be positioned adjacent a roof of [a] mouth” and “configured to be received in a sublingual pocket[] of the mouth” while its transition section (alleged by the Examiner to be the hollow space 5) is a configured to “receive a portion of a tongue.” *Id.*

The Examiner responds that Zeindler’s “area of 5 is equivalent [to] a transition section” because it lies “between the upper mouth member 4 and the sublingual member (the lower area of 4)” and has “a profile that defines a pocket (the area of 8 and 9 which are embedded in a flexible plastic tube 12[, which] has some sort of flexibility in the area 12 in order to be considered as a pocket)” that is considered by the Examiner to be “configured to receive a portion of a tongue of the user.” Ans. 3–4. The Examiner contends that the recited “configured to” language in claim 17 amounts to a statement of intended use, which “are deemed not to impose any structural limitations on the claims” because Zeindler’s device is capable of being used as claimed. *Id.* at 4.

Appellant replies that the Examiner is relying on Zeindler’s parts 8 and 9 to disclose the claimed pocket defined by the transition section, whereas Zeindler states that “parts 8 and 9 form a kind of press button in which the temperature sensor 7 is encased.” Reply Br. 2–3 (citing Zeindler 2:22–23).

We agree with Appellant that Zeindler fails to disclose a transition section between an upper mouth member configured to rest adjacent the mouth roof, and a sublingual member configured to be received in the sublingual pocket, the transition section having “a profile that defines a pocket configured to receive a portion of a tongue of the user.” First, Zeindler fails to disclose a defined pocket. In addition, we disagree with the Examiner that the functional language of claim 17 fails to impose any structural limitations on the claims.

There is nothing intrinsically wrong with defining something by what it does rather than what it is while drafting a patent claim. *See In re Swinehart*, 439 F.2d 210, 212–213 (CCPA 1971). When applicants use functional language to differentiate the claimed subject matter from the prior art, it is incumbent upon the Examiner to show that the prior art is capable of performing the claimed function. *See id.*

The structure of Zeindler must be capable of (1) being positioned adjacent a roof of a mouth of a user, (2) being received in a sublingual pocket of the mouth of the user, and (3) defining a pocket configured to receive a portion of a tongue of the user. The Examiner has failed to support a finding that the structure of Zeindler is capable of performing these three functions. We therefore do not sustain the pending rejection.

DECISION

We REVERSE the rejection of claims 13–17 under 35 U.S.C. § 102(b) as anticipated by Zeindler.

Appeal No. 2015-000649
Application No. 13/296,092

REVERSED